

### **REMARKS**

The Office Action mailed October 25, 2004 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

#### **I. Summary of Claims**

Claims 1-26 are currently pending in the application, with claims 1, 12, and 23 being independent claims. Claims 1 and 23 are amended, in accordance with the above amendments.

Although claims 23-26 are indicated as rejected, a first page of the Office Action only indicates that claims 1-22 are pending in the application. The Applicants respectfully note this apparent oversight for the record.

#### **II. Office Action Summary**

The Office Action indicates that claims 12-22 are allowed. In addition, the following claim rejections were submitted by the Examiner:

- Claims 1, 2, 7, 10, and 23-26 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 4,942,679 to Brandon, et al.;
- Claims 1-5, 7, 10, and 23-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of British Patent Number 483,028 to Grouven and Brandon;
- Claims 1, 8, 10, 11, and 23-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of U.S. Patent Number 2,498,624 to Skinner and Brandon;
- Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over any of the above rejections further in combination U.S. Patent Number 5,896,682 to Lin.

#### **III. Summary of Applied Prior Art**

##### ***Discussion of Brandon***

Brandon discloses an article of footwear, particularly a loafer, having a raised heel area and an insole within the upper. The insole varies in thickness. With reference to Figure 1, the heel area of the insole has a greater thickness than the forefoot area. In a centrally-located area,

however, the insole exhibits the greatest thickness in a metatarsal pad that underlies the metatarsals of the foot. According to Brandon, "the metatarsal pad 56 is thicker than the surrounding area of the insert piece 48...to more adequately support the natural depressed area in the foot immediately behind the ball of the foot" (Brandon, column 6, lines 50-55). In addition, the footwear includes at least one constant thickness layer of a foam material extending through the forefoot and heel regions and located under the insole.

#### *Discussion of Skinner and Grouven*

Skinner discloses a removable insert for footwear having the form of a boot. In general, the footwear has a heel block situated in a heel region of the footwear and an outsole that extends from the forefoot region to a heel region of the footwear. Whereas the outsole forms the ground-engaging portion of the footwear in the forefoot region, the outsole extends above the heel block in the heel region. Accordingly, the heel block forms the ground-engaging portion of the footwear in the heel region. Grouven exhibits a similar structure.

### **IV. The Claims Patentably Distinguish Over The Applied Prior Art**

#### *Discussion of Independent Claim 1*

Independent claim 1 recites various features of an article of athletic footwear having an upper, a foot-supporting member, and a sole structure. The upper covers at least a portion of a foot of a wearer. The foot-supporting member is removably-received by the upper, and the foot-supporting member has a lower surface located opposite a foot-engaging surface. The lower surface is at a first elevation in a forefoot region of the foot-supporting member, and the lower surface is at a second elevation in a heel region of the foot-supporting member. The second elevation is greater than the first elevation to define a recess below the heel region. The foot-supporting member also has a first thickness in the forefoot region and a second thickness in the heel region, the first thickness being greater than the second thickness throughout a substantial portion of the forefoot region. The sole structure is attached to the upper. In addition, the sole structure includes a polymer foam material located under at least the heel region of the foot-supporting member, the foam having greater thickness under the heel region than under the forefoot region.

For purposes of the following discussion, selected features of the footwear recited in independent claim 1 include:

- The footwear is an athletic article of footwear;
- The first thickness is greater than the second thickness throughout a substantial portion of the forefoot region; and
- The foam located under at least the heel region of the foot-supporting member and has greater thickness under the heel region than under the forefoot region.

Based upon the following discussion, the Applicants submit that these collected features are taught or suggested by the applied prior art.

None of the applied prior art discloses an athletic article of footwear. Rather, Brandon, Grouven, and Skinner disclose footwear having a sole that is conventional in casual articles of footwear, such as loafers and boots. Although casual and athletic articles of footwear each incorporate an upper and sole structure, the configuration of these elements differs substantially between casual and athletic articles of footwear.

Neither Brandon nor Grouven disclose the first thickness as being greater than the second thickness throughout a substantial portion of the forefoot region. In Brandon and Grouven, the midfoot region exhibits an increased thickness that may extend into the forefoot region. That is, both of these references disclose a substantial portion of the forefoot region as actually being thinner than the heel region.

Regarding the final feature noted above, none of the applied prior art discloses the foam located under the heel region of the insoles as having greater thickness than the foam located under the forefoot region. In Brandon, the foam layers 45 and 47 exhibit a constant thickness.

Based upon the above discussion, the Applicants respectfully submit that independent claim 1 is allowable over the applied prior art. In addition, claims 2-11 should be allowable for at least the same reasons.

*Discussion of Independent Claim 23*

Independent claim 23 recites various features of an article of athletic footwear having an upper, a foot-supporting member, and a sole structure. The upper defines a void. The foot-supporting member is removably-received by the void and has a heel region and a forefoot region. The heel region is positioned at a greater elevation than the forefoot region. In addition, the heel region has a thickness that is less than a thickness of a portion of the forefoot region that underlies phalanges of a foot of a wearer. The sole structure is secured to the upper, and the sole structure includes a foam material protruding into the void.

For purposes of the following discussion, selected features of the footwear recited in independent claim 1 include:

- The heel region has a thickness that is less than a thickness of a portion of the forefoot region that underlies phalanges of a foot of a wearer; and
- The foam material of the sole structure protrudes into the void.

Based upon the following discussion, the Applicants submit that these collected features are taught or suggested by the applied prior art.

Neither Brandon nor Grouven disclose the heel region as having a thickness that is less than a thickness of a portion of the forefoot region that underlies phalanges of a foot of a wearer. In Brandon, the metatarsal pad 56 underlies the metatarsal bones, but does not underlie the phalanges. Based upon Figure 2 of Grouven, the area of the insole under the phalanges is significantly thinner than the heel region. In other words, both of these references disclose the area corresponding to the phalanges as being relatively thin.

Regarding the second feature noted above, none of the applied prior art discloses the foam material of the sole structure as protruding into the void. In Brandon, the foam layers 45 and 47 exhibit a constant thickness.

Based upon the above discussion, the Applicants respectfully submit that independent claim 23 is allowable over the applied prior art. In addition, claims 24-26 should be allowable for at least the same reasons.

**V. Conclusion**

In view of the foregoing, the Applicants respectfully submit that all claims are in a condition for allowance. The Applicants respectfully request, therefore, that the rejections be withdrawn and that this application now be allowed.

This Amendment is being timely filed by facsimile transmission on November 19, 2004. Should additional fees or an extension of time be deemed necessary for consideration of this Amendment, such fees or extension are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fee. If anything further is desirable to place the application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

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